

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT BARBIERI and PETER J. BERGENDAHL

Appeal No. 2004-1129
Application No. 09/755,513

ON BRIEF

Before PAK, TIMM and PAWLIKOWSKI, **Administrative Patent Judges**.
PAWLIKOWSKI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-7, 9, 10, 11, 13-20 and 22-34.

Claim 1 is representative of the subject matter on appeal and is set forth below, wherein the text in bold is for emphases only:

1. A snowboard comprising:
a running length having opposite ends, two sides and a sidewall extending along at least a portion of one of the two sides of the running length, the running length having an area for mounting a first snowboard binding and a second snowboard binding;
a nose located at one end of the running length;
and
a tail located at other end of the running length, the nose and tail each having a transition end near the running length and a tip opposite the transition end, at least one of the nose and tail having a continuously increasing flexibility along a substantial length of the at least one of the nose and tail from the transition end toward the tip, wherein the increasing flexibility is not exclusively the result of a change in width of the at least one of nose and tail.

The examiner relies upon the following references as evidence of unpatentability:

Vance	5,871,224	Feb. 16, 1999
Olson	5,921,564	Jul. 12, 1999
Zanco et al. (Zanco)	6,113,126	Sep. 05, 2000

Lines 27-29 of page 1 of the Instant Application, which is part of the "Background" portion of the Instant Application.

Claims 1-3, 5, 7, 9, 10, 13, 14, 16, 18-20, 22, 23, 25, and 27-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zanco in view of lines 27-29 of page 1 of appellants' specification (herein after referred to appellants' admitted prior art, APA).

Claims 4 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zanco in view of APA.

Claims 11, 24, and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zanco in view of APA and further in view of Vance.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zanco, in view of APA, and further in view of Olson.

On page 5 of the brief, appellants state that the claims stand or fall together. We therefore consider claim 1 in this appeal. See 37 CFR § 1.192(c)(7) and (8)(2003).

OPINION

Beginning on page 5 of the answer, the examiner explains the teachings set forth in Zanco. In particular, at the top of page 6 of the answer, the examiner states that Figure 1 of Zanco "clearly teaches that the tip and tail have a decreasing thickness, however, this is not explicitly stated in the written portion of the disclosure." Upon our review of Figure 1 of Zanco, it is difficult to draw the conclusion that the examiner has drawn. That is, the uncertainty of whether the figure is drawn to scale, etc., cannot support the conclusion with certainty that the tip and tail shown in Zanco's Figure 1 have a decreasing thickness. Nevertheless, the examiner refers to appellants' admitted prior art at lines 27-29 on page 1 of appellants' specification and relies on this admitted prior art for that cap-type snowboards are known to have a nose with a core of tapered thickness and that this type of construction results in increased flexibility from the transition, or the contact area toward the tip of the nose. An increase flexibility toward the nose results in increased "float" which facilitates gliding in deep snow. Then, the examiner concludes that therefore it would have been obvious to have modified the board of Zanco by modifying the nose so that it tapers towards the tip to achieve increased flexibility resulting in an increased in "float." (Answer, page 6).

Beginning on page 12 of the answer, the examiner provides more detail of his position. The examiner states that Figure 10 of Zanco specifically teaches that front and rear portion of the board includes tip and tail regions. On page 13 of the answer, the examiner states that Zanco does not indicate that the board shown in Figure 10 is not to be used in powdered snow or would not perform adequately in powdered snow.

Hence, in view of the above, it appears that the examiner first referred to Figure 1 of Zanco for illustrating a nose and tail that taper toward the tip. Then the examiner also refers to Figure 10 which has a cap construction at the nose and a tail and sidewall construction along at least a portion of one of the two sides of the running length.

Appellants argue that their claims focus on the region of the snowboard extending beyond the front end of the running length (the nose) and behind the rear end of the running length (the tail). Brief, page 5. Appellants argue that Zanco is not concerned about the construction of property at nose or tail ends. (Brief, pages 5-6). Appellants argue that rather, Zanco's focus is on the intermediate region of the gliding board that is in front of the tail behind the nose. (Brief, page 6). Appellants also explain that 3 and is directed to combining three basic gliding board constructions, sidewall and mix sidewall and cap along the running length of a single gliding board. (Brief, page 6).

Appellants also explain that the ski illustrated in Figure 9 of Zanco is the only embodiment in which Zanco indicates that is particularly suited for powdered snow. Appellants state that there is no expressed teaching in the art of record that it would have been obvious based on any teaching in the record or knowledge in the art to modify the sidewall constructed segments

at the nose and tail ends of the running length of the gliding water Figure 9 of Zanco to provide a increasing or varying flexibility of the nose and/or tail ends. (Brief, page 6).

Appellants state that they noted this deficiency during prosecution and in response, the examiner pointed the embodiment of Figure 10 of Zanco indicating that here the primary reference disclosed a front region with a cap construction and an intermediate region that was configured with a sidewall, and that it would have been obvious in view of appellants' admitted prior art, to provide the cap constructed segment at the front end of the running length with a tapered thickness. Appellants argue that the ski depicted in Zanco's Figure 10 is a ski that is suitable for carving turns on a groomed surface not one that is particularly suited for uses and conditions in which float is desired. At the top of 7 of the brief, appellants further argue that the combination of Figure 10 in Zanco with the admitted prior art is flawed for several reasons. Appellants argue that the admitted prior art is directed specifically to the make-up of the nose and tail regions of a board and not to the portions of the running length that are adjacent to, but not part of, these end sections of the board which is in contrast to Zanco. Appellants argue and we reiterate that Zanco does not discuss properties or construction of the nose and tail sections of its disclosed embodiments.

On page 13 of the answer, the examiner rebuts and states that independent claim 1 makes no mention of powdered snow and therefore the comments regarding powdered snow does not pertain to claim 1. Since we are considering claim 1 in this appeal only because appellants state that the claims stand or fall together, this statement made by the examiner is important.

The examiner states that there is no teaching that the ski shown in Zanco's Figure 10 is not to be used in powdered snow. Critical to our determinations in this decision is the issue raised on page 6 of appellants' brief. This issue is whether one skilled in the art would have been motivated to modify the board of Zanco (whether this board is the Board shown in Figure 9 or Figure 10) such that at least one of the nose and tail has a continuously increasing flexibility along a substantial length from the transition end toward the tip wherein the increasing flexibility is not exclusively the result of a change in width of at least one of the nose and tail. The examiner believes that motivation does exist in view of appellants' admitted prior art found at lines 27-29 of page 1 of appellants' specification. Here, appellants' specification indicates that to improve flow in deep snow, some cap type construction boards have been provided with a core that has a tapered thickness at the nose. This tapered thickness of the core results in a cap type board having a nose that increases in flexibility from the transition or contact area toward the tip of the nose. This increased flexibility allows the nose to flex upward to a varying degree along the nose when contacted by snow, thereby increasing frontal area on the nose in amount of lift provided to the board. (See page 1, line 27 through page 2, line 3 of appellants' specification).

As discussed above, appellants argue that Zanco is not concerned with the constructional properties of the nose or tail ends, rather, with the intermediate region of the gliding wall this in front of the tail and behind the nose. In this way, appellants argue that no motivation exists therefore to bother to modify the nose or tail ends of the board of Zanco.

We know however that motivation can be found in teachings other than that found in the primary reference. Here, as discussed by the examiner, appellants' admitted prior art does teach the skilled artisan that if one wanted to have a board with improved float, such can be accomplished by providing a board with a core has a tapered thickness at the nose. Appellants' arguments do not convince us that the board depicted in Zanco's Figure 10 should not be modified to achieve improved float. Apparently the board in Figure 10 is directed to a ski specialized in the practice of skiing tight turns. (See column 3, lines 32-35 of Zanco). Appellants have not adequately explained why a ski providing benefits regarding tight turns would not also want to be tailored to have improved float.

On page 8 of the brief, appellants argue that Zanco teaches away from the claimed invention. Appellants state that Figure 9 of Zanco is directed to powder application and that Figure 10 is not directed to powder application but rather is intended as a turn carving board. Appellants argue that the relevant embodiment of Zanco discloses a powdered board with a sidewall construction at the nose to provide better placement of the board on the snow. Appellants state therefore Zanco teaches away from preferred arrangement as disclosed in their application of a Board gliding with a nose formed of cap construction.

However, as pointed by the examiner, Zanco does disclose in Figure 10 a board with a nose formed of a cap construction. Although appellants argue that this board in Figure 10 is intended as turn carving board, appellants have shown that it cannot function in powder applications. In this context, we agree with the examiner's statement made page 13 of the answer that there is no teaching in Zanco that Figure 10 is not to be

used in powdered snow or will not perform adequately in powdered snow. Appellants do not dispute this statement made by the examiner. Appellants have not adequately convinced us that one of ordinary skill in the art would have been dissuaded from modifying the nose shown in Zanco's Figure 10 which is formed a cap construction such that it has increasing flexibility along a substantial length simply because Zanco indicates that the board in Figure 10 is particularly suitable for the practice of skiing with tight turns.

In view of the above, we therefore affirm the rejection.

II. The reply brief

We have also carefully reviewed appellants' reply brief.

Beginning on page 1 of the reply brief, appellants again argue that the combination is in error. Appellants argue that there would have been no motivation to modify the on-piste styling board of Figure 10 of Zanco with the peculiar nose tail construction of the off-piste admitted prior art board. Appellants state that admitted prior art in fact teaches away from the reference combination as cap-type boards configured for any riding style other than powder. On page 2 the reply brief, appellants also argue that snowboards and skis are design for different condition and riding styles. Appellants argue that ski shown in Figure 10 of Zanco is design for on-piste condition (groomed slopes). On page 3 of the reply brief appellants argue that there is no motivation to make the combination. Appellants reiterate that there is no incentive for one skilled in the art to combine on the on-piste board of Zanco with the off-piste nose tail of the admitted prior art. Finally, at the bottom of page 3 of the reply brief, appellants argue that with regard to anticipation, Zanco's written description is silent regarding

the thickness of the nose or tail with which we agree as discussed above.

We fully appreciate appellants' discussion of the kinds of conditions the ski as depicted in Figure 10 is best suited. As we discussed above, Zanco clearly states in column 3 beginning at line 32 that the ski depicted Figure 10 is specialized in the practice of skiing with tight turns. However, as pointed out by the examiner and as we agree, such disclosure does not exclude the suitability of such a ski in powder conditions when the nose or tail are modified according to appellants' admitted prior art. The issue really here is whether one skilled in art would not modify a ski such as the ski depicted in Figure 10 simply because Zanco's disclosure indicates it is best suited for skiing with tight turns. This is exactly what appellants have not convinced us of in both their brief and reply brief. Hence, as determined above, we affirm the rejection.

III. The other art rejections

Because appellants state that the claims stand or fall together and because the arguments made by appellants are directed to Zanco and the admitted prior art, we similarly affirm all the other rejections and do not need to discuss the secondary references involved therewith.

IV. Conclusion

Each of the rejections is affirmed.

Appeal No. 2004-1129
Application No. 09/755,513

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
)	APPEALS AND
CATHERINE TIMM)	INTERFERENCES
Administrative Patent Judge)	
)	
)	
)	
)	
)	
BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

BAP/sld

Appeal No. 2004-1129
Application No. 09/755,513

WOLF GREENFIELD & SACKS, P.C.
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211